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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,088	02/17/2004	Robert J. Simmons	J-BSIM.1011	3395
56703	7590	10/11/2007	EXAMINER	
ROBERT D. VARITZ, P.C.			WENDELL, MARK R	
4915 SE 33RD PLACE			ART UNIT	PAPER NUMBER
PORTLAND, OR 97202			3635	
			MAIL DATE	DELIVERY MODE
			10/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/781,088	SIMMONS, ROBERT J.
	Examiner	Art Unit
	Mark R. Wendell	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 September 2007.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 September 2007 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

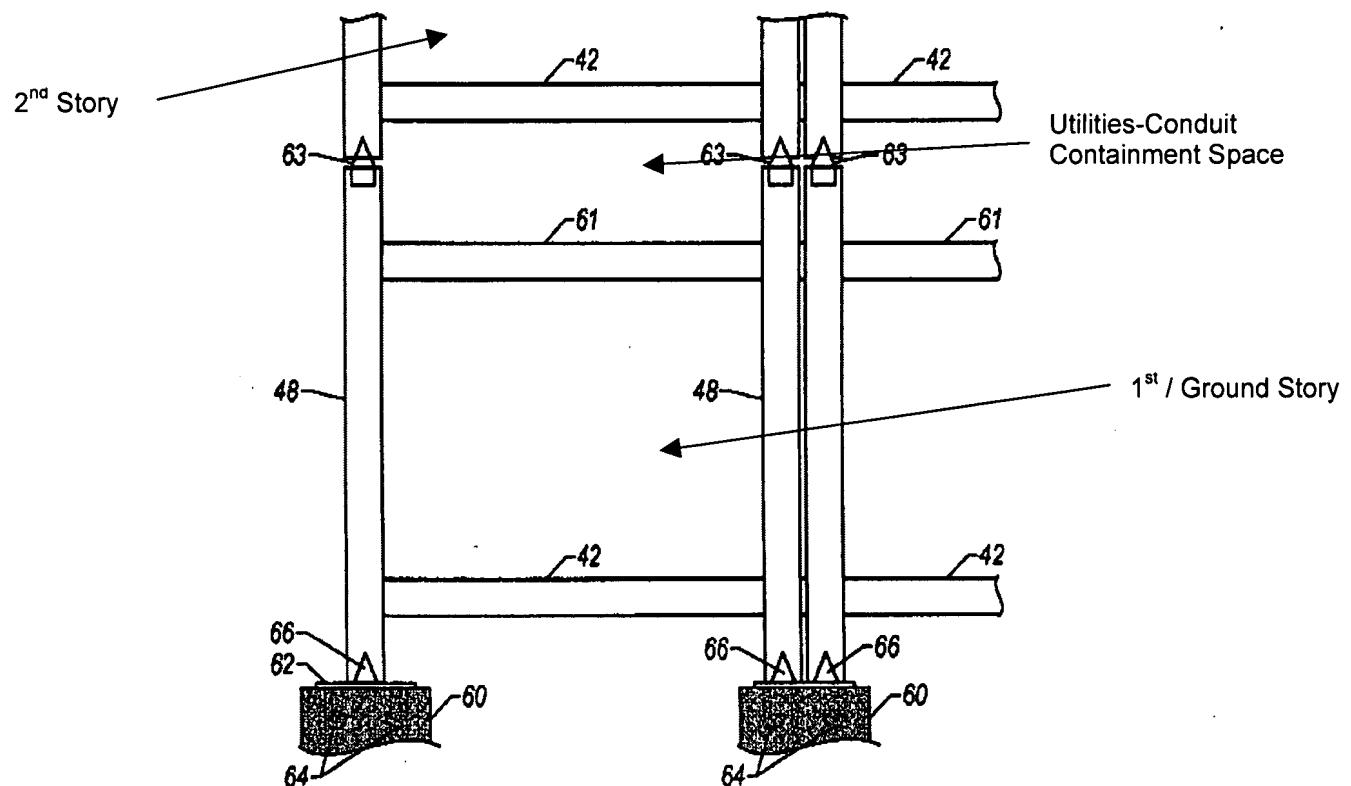
A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al. (US 6625937). Parker illustrates in Figures 3A and 6 a plural-story building comprising:

- A pair of vertically spaced stories including a lower and higher story, each having a normal full-plate height and volume (see modified Figure below); and,
- A utilities-conduit containment space in between the lower and higher stories (see modified Figure below).

The examiner notes that the utilities-conduit containment space of Parker is “adapted to contain utilities conduit structure.” The examiner further notes that the containment space of Parker is capable of housing utilities, or utility conduits.



**FIG. 6**

Figure 6 of Parker

Regarding claim 2, Parker discloses that the containment space is built with support beams (61) made from steel. It is notoriously well known within the art of building construction that steel is water impervious. Therefore the containment space, with its underlying steel supports, is "appropriately lined" (with the metal support lining the floor) against liquid drainage to the lower story.

Regarding claim 3, Parker illustrates in Figure 6 and discloses in Column 5, lines 7-10, the lower story being a ground level story.

Regarding claim 6, Parker illustrates in Figures 3A and 6 a plural-story building comprising:

- A vertical stack of stories including plural normal-height stories (see modified Figure above);
- A less-than-normal-height sub-story with an internal volume (see modified Figure above).

The examiner notes that the sub-story of Parker is “adapted to contain utilities conduit structure.” The phrase “adapted to” is vague and the examiner notes that the sub-story of Parker could house utilities, or utility conduits.

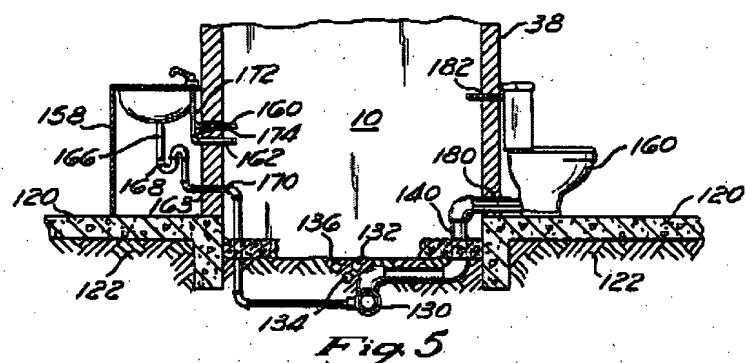
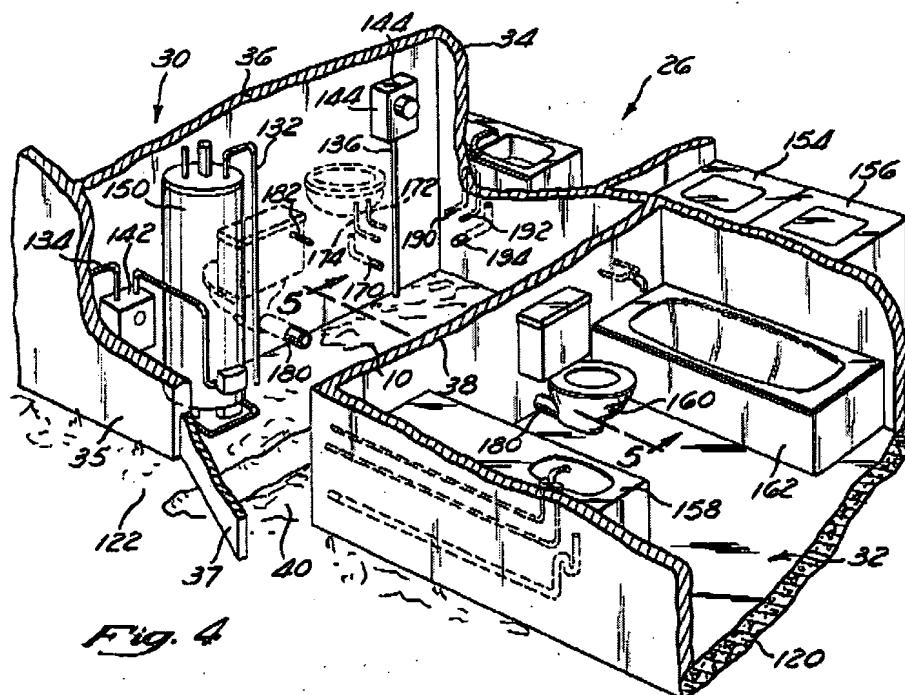
### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6625937) in view of Douglass, Jr. (US 4341052). It is described above for claims 1-3 and 6 what is disclosed, or illustrated, in Parker. Parker does not disclose a utility-conduit structure within the containment space that includes supply-input portions. However, Douglass illustrates in Figures 4 and 5 a containment space (30) with utility

supply-input portions (160, 162, 170, 140). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the containment space of Parker to include the utility supply-input portions of Douglass with the motivation of providing utilities to an adjacent room.



#### Figures 4 and 5 of Douglass, Jr.

Regarding claim 5, Parker discloses that the containment space is built with support beams (61) made from steel. It is notoriously well known within the art of building construction that steel is water impervious. Therefore the containment space, with its underlying steel supports, is "appropriately lined" (with the metal support lining the floor) against liquid drainage to the lower story.

***Response to Arguments***

Applicant's arguments filed 9/11/2007 have been fully considered, however they are not persuasive. Regarding specific comments and arguments, the examiner fully appreciates the phonetic spelling, definition, and origins of the individual words within the misunderstood phrase, "directly vertically intermediate," yet notes that the confusion of terms did not lie within individual words as suggested by the attorney, but within the combination. The examiner is also grateful for the breakdown of the word "comprehensible." It has made the word "comprehensible" more comprehensible to the examiner. The examiner merely suggested alternate verbiage so as to lend an easier understanding for the public. It is the examiners duty to serve the public and be sure that the applicant's invention is presented in a CLEAR and CONCISE manner. It should be considered that what may be understood by the examiner, applicant, and attorney may not be easily received by the public. Regarding the attorney's thoughtful gesture in offering a "Word-A-Day" calendar, the attorney should dually note 37 CFR 1.3, it states,

"applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy."

Regarding applicant's argument to the rejection of claims 1 and 6, all of the claimed limitations are either illustrated or disclosed within the specification. The applicant's argument is based on the phrase "adapted to contain utilities-conduit structure relevant to the supply of utilities services upwardly from said containment space toward said higher story, with related utilities services supply to said utilities-conduit structure extending thereto in a manner avoiding any presence within the mentioned internal volume of said lower story." It has been held that the recitation that an element is "adapted to" perform a function not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). The examiner notes that the higher story of Parker is capable of being a utilities storage space.

Regarding applicant's argument to the rejection of claim 2, Parker meets the claimed structural limitation of a water impervious lining. The examiner also notes that in column 4, lines 25-30, Parker discloses the floor member consisting of structural steel beams which are, by nature, water impervious.

Regarding the applicant's argument to the rejection of claim 4, the applicant again is basing the argument solely on the statement of "supply-input portions **adapted** for

connection to related utilities services supplies which are external to the building structure, with such connection **adaptation** accommodating interconnection between said utilities-conduit structure and such external supplies in a manner avoiding any presence within the internal volume of said lower story." It has been held that the recitation that an element is "adapted to" perform a function not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). The examiner notes that the higher story of Parker is adapted to have utility conduits and supply input portions, such as those of Douglass, Jr., within it. Furthermore, the supply-input portions of Douglass, Jr. are capable of being located external to the building structure.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Wendell whose telephone number is (571) 270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richard Chilcot  
Supervisory Patent Examiner  
Art Unit 3635

MRW  
October 9, 2007